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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/823,823	03/25/97	TAUGHER	L 10970451-1

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WM02/0717

EXAMINER	
NEYZARI, A	
ART UNIT	**PAPER NUMBER**
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 28

Application Number: 08/823,823
Filing Date: 3/25/97
Appellant(s): Taugher

Taugher
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 6-8-2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-11 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Prior art disclosed in page 1-4 of the specification

Parker and Starrett, CD-ROM Professional's CD-Readable Handbook, 1996, page 82

JP404095287	Takahashi et al	3-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 3, the phrase "capable of" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed in the specification in view of Parker and Starrett and further in view of Japanese patent No 404095287 to Takahashi.

In page 1-4 of the specification applicant admits that write protection in rewritable disks are well known in the art. Applicant also admits that power calibration area are used in optical disks for calibrating laser power, since laser writing must be calibrated for each disk. This is a conventional method which also is disclosed by Kuroda et al as prior art (supporting document). Page 82 of "CD Recordable Handbook" by "Parker and Starrett", cited by applicant also discuss the Program Memory Area (PMA) and Power Calibration Area (PCA) on CD-R disks.

To cover any area of any subject in order to prevent an operation to take place in such an area is a common practice and is nothing new in the art. In fact Takahashi in Japanese patent No 404095287 discloses recording inhibition by detachable seal 8 (Fig 1).

Therefore it would be obvious when the power calibration area is covered by any means (such as a ring, since this is a circular area) the laser power calibration becomes impossible, which this can affect the operation of the system such as preventing the disk from rewriting.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to cover the calibration area of the prior art disk in order to affect the

operation of the system, operation such as rewriting in the disk, as taught by combination of above references.

(11) Response to Argument

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available to one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Patent Examiner
Art Unit 2651
July 11,2001

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